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09/555,233	07/13/2000	AKITOSHI KOJIMA	P-9904 S	1035

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EXAMINER
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MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

PLG

## Office Action Summary

Application No.

09/555,233

Applicant(s)

KOJIMA, AKITOSHI

Examiner

Aravind K Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/23/00
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Network Authentication System Using Individual Service Providers and an Authentication Server.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 1, 5, 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1 is directed towards a network system comprising a plurality of individual service providers each having access points and a parallel service provider connected to the plurality of individual service providers and an authentications server. A review of the specifications reveals that elements are entirely software and includes no tangible elements. The examiner suggests incorporation of a computer or a computer readable medium to avoid this rejection.

Claims 2-4 add additional software elements or more detail to elements recited in claim

1.

Claims 5 is directed towards determining by the access point whether the user is a member of an individual service provider, executing user authentication processing by the access point itself when the user is a member of the individual service provider, connecting the user to a

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network in accordance with a result of the authentication processing, causing the parallel service provider to execute user authentication processing when the user is a member of the parallel service provider, and connecting the user to the network in accordance with a result of the authentication processing. A review of the specifications reveals that elements are entirely software and includes no tangible elements. The examiner suggests incorporation of a computer or a computer readable medium to avoid this rejection.

Claims 6 and 7 add additional software elements or more detail to elements recited in claim 5.

Claims 8 is directed towards determining whether an electronic mail address including a combination of the user name and any one of a plurality of predetermined sub-domains has been registered and means for determining an electronic mail address including a combination of the user name and another sub-domain has been registered. A review of the specifications reveals that elements are entirely software and includes no tangible elements. The examiner suggests incorporation of a computer or a computer readable medium to avoid this rejection.

Claims 9 is directed towards means for determining whether the user is a regular member of a provider with which the user contracts or a partnership member under a given contract with the provider, means for, when the user is a regular member, executing user authentication processing and connecting the user to a network in accordance with a result of the authentication processing; and means for, when the user is a partnership member, transferring a connection request to a specified authentication server, and executing user authentication processing and connecting the user to the network in accordance with a result of the authentication processing. A review of the specifications reveals that elements are entirely software and includes no

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tangible elements. The examiner suggests incorporation of a computer or a computer readable medium to avoid this rejection.

Claims 10 and 11 add additional software elements or more detail to elements recited in claim 9.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**3. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al U.S. Patent No. ~~6~~6,282,575 B1.**

As to claim 1, Lin et al suggests a network system comprising a plurality of individual service providers each having access points [column 4, lines 34-45]. Lin et al discloses a parallel service provider connected to the plurality of individual service providers and including an authentication server [figure 2 and accompanying description]. Lin et al discloses that the access point of the individual service providers receives a connection request from a user who contracts

with the parallel service provider, the providers cause the authentication server to perform user authentication and connect the user to a network through the access point in accordance with a result of the authentication [column 4, lines 34-45].

As to claim 2, Lin et al discloses that the user who contracts with the parallel service provider send a connection request containing a domain name of the parallel service provider to the access point [column 4, lines 34-45]. Lin et al discloses that the access point determines whether the user contracts with the parallel service provider in accordance with presence or absence of the domain name [column 2, lines 1-10].

As to claim 3, Lin et al suggests that the parallel service provider is connected to the plurality of individual service providers through an exclusive line [figure 2 and accompanying description].

As to claim 9, Lin et al discloses a connection request issued from a user [figure 3 and accompanying description]. Lin et al discloses determining whether the user is a regular member of a provider with which the user contracts or a partnership member under a given contract with the provider [figure 3 and accompanying description]. Lin et al discloses that when the user is a regular member, executing user authentication processing and connecting the user to a network in accordance with a result of the authentication processing [figure 3 and accompanying description]. Lin et al discloses that when the user is a partnership member, transferring a connection request to a specified authentication server, and executing user authentication processing and connecting the user to the network in accordance with a result of the authentication processing [column 4, lines 34-45].

As to claim 10, Lin et al discloses that the partnership member inserts a predetermined domain name in the connection request [column 2, lines 1-10]. Lin et al discloses that the determining means determines whether the user is the partnership member in accordance with presence or absence of the domain name in the connection request [figure 3 and accompanying description].

As to claim 11, Lin et al suggests that the specified authentication server is connected to network connection devices of a plurality of companies and used in common [figure 2 and accompanying description].

**4. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Partridge, III U.S. Patent No. 5,384,848 (hereinafter Partridge).**

As to claim 5, Partridge discloses sending a connection request from a user to an access point of any one of a plurality of individual service providers [column 7, lines 45-52]. Partridge discloses determining by the access point whether the user is a member of an individual service provider including the access point or a member of a parallel service provider that contracts with the plurality of individual service providers [column 3, lines 18-35]. Partridge discloses executing user authentication processing by the access point itself when the user is a member of the individual service provider [column 3 line 40 to column 4 line 48]. Partridge discloses connecting the user to a network in accordance with a result of the authentication processing [column 3 line 40 to column 4 line 48]. Partridge discloses causing the parallel service provider to execute user authentication processing when the user is a member of the parallel service provider [column 4 line 43 to column 5 line 47]. Partridge discloses connecting the user to the

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network in accordance with a result of the authentication processing [column 4 line 43 to column 5 line 47].

As to claim 6, Partridge suggests that the user who contracts with the parallel service provider send a connection request containing a domain name of the parallel service provider to the access point [figure 2 and accompanying description]. Partridge discloses that the access point determines whether the user contracts with the parallel service provider in accordance with presence or absence of the domain name [figure 2 and accompanying description].

**5. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Wayback Machine.**

As to claim 8, Wayback Machine suggests that when a user name is input, determining whether an electronic mail address including a combination of the user name and any one of a plurality of predetermined sub-domains has been registered. Wayback Machine suggest that when the electronic mail address has been registered, determining an electronic mail address including a combination of the user name and another sub-domain has been registered, whereby setting an electronic mail address and including a combination of a sub-domain not registered and a user name.

The examiner asserts that Wayback Machine was used to show that hotmail was in use prior to the priority date. The examiner asserts that hotmail determines whether an electronic mail address including a combination of the user name and any one of a plurality of predetermined sub-domains has been registered. Hotmail also determines an electronic mail address including a combination of the user name and another sub-domain has been registered, whereby setting an electronic mail address and including a combination of a sub-domain not registered and a user name.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partridge, III U.S. Patent No. 5,384,848 (hereinafter Partridge) as applied to claims 1 and 5 above, and further in view of Carnegie et al U.S. Patent No. 5,745,884.**

As to claims 4 and 7, Partridge does not teach that the plurality of individual service providers sends respective user connection recordings to the parallel service provider.

Carnegie et al teaches that service providers send respective user connection recordings to the parallel service provider [figure 3 and accompanying description].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Partridge so that the service providers would have sent out user connection recordings to the parallel service provider.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Partridge by the teaching of Carnegie et al because it helps operators of such networks to facilitate collection of revenues for service [column 3, lines 47-54].

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*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1373.

Aravind K Moorthy  
October 14, 2003

  
**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**